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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,698	02/13/2001	Lester Sussman		1433

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JAKETIC, BRYAN J

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/781,698	SUSSMAN, LESTER
	Examiner Bryan Jaketic	Art Unit 3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 March 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

 | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. The use of the trademark BLUETOOTH has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

2. Claim 12 is objected to because of the following informalities: in line 1 of the claim, "method" should be --system--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 6 is unclear, because steps (b) and (c) are apparently incompatible. Step (c) involves a customer picking up items in a drive through service, after the items have already been delivered to the customer in step (b).

6. Claims 7 and 11 are rendered indefinite by the use of the trademarked term BLUETOOTH, and by reference to the “Bluetooth radio frequency standard.” MPEP § 608.01(v) states, “the examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trademark or by the name used in trade.” Furthermore, the “Bluetooth radio frequency standard” is indefinite, because such a standard may be subject to change over time.

7. Claims 1-8 are rendered indefinite by the use of both method and apparatus language. Applicant claims a method in the preamble of claim 1, but the body of the claim is directed towards components of an apparatus. Furthermore, Applicant claims a system in the preamble of dependent claims 2-4, 7 and 8, and a method in the preamble of dependent claims 5 and 6.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 9, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruppert et al. Ruppert et al disclose a system for scanning shopping list item bar codes comprising a host computer comprising logic that stores frequently used shopping list information (see abstract, and col. 8, lines 52-53) and a personal digital assistant with a

code scanner (Fig. 1) comprising a processor (40); a memory (43); logic that obtains a product identifier from a bar code, creates a query, transmits the product identifier, and displays information (see col. 6, lines 19-38 and 49-55; and columns 8 and 9); wherein the information relates to product cost (see col. 8).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppert et al. Ruppert et al disclose a system and method for creating a shopping list and purchasing items from the list comprising a personal digital assistant (Fig. 1) including a data system (40 and 43) for receiving product identification data from a UPC selected by a consumer for inquiry (see col. 6, lines 49-55), and a data communication system (85) for communicating data on a network infrastructure to a merchant computer system, wherein the merchant computer system includes a database that stores product descriptive information (see col. 6, lines 19-38). Ruppert et al further disclose a display (see Fig. 1) for displaying information associated with the product identifier. Ruppert et al further teach the steps of shopping in a store's aisles and delivering the items to the customers shopping basket (see Fig. 5, and columns 8 and 9).

Ruppert et al do not disclose a first network that interfaces with the portable interface unit through a LAN, and interfaces the merchant computer system through the Internet. However, it is common in the art to connect a personal digital assistant to a personal computer through a LAN, wherein the computer is connected to other computer systems through the Internet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a personal computer as an intermediary with the invention of Ruppert et al to store information so that less memory is used in the personal digital assistant. Furthermore, use of the Internet is common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the Internet with the invention of Ruppert et al because the Internet is a convenient means of communication.

While Ruppert et al teach the step of matching product identification data to descriptive information (see col. 8 and 9), Ruppert et al do not teach that the descriptive information consists of information representing other products which are complimentary with the products. However, these differences are only found in the nonfunctional descriptive material and do not alter the way the information is matched and transferred. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to match the product identifier to complimentary

information because the type of information being matched with the product identifier does not patentably distinguish the claimed invention.

Ruppert et al do not teach the steps of the merchant picking and packing the items, and the customer picking up the items in a drive through service. However, such drive through services are common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the steps of the merchant picking and packing the items, and the customer picking up the items in a drive through service to make the process more convenient for the customer.

Ruppert et al do not teach the step of communicating through a radio frequency channel on a Bluetooth radio frequency standard. However, radio communication is common in the art, as is the Bluetooth standard. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a Bluetooth radio standard communication channel to allow for fast, wireless communication instead of cumbersome wired connections.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jelen et al, Smith et al, and Overman disclose portable grocery list devices. Roberts and Kolawa et al disclose systems for creating a shopping list. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Jaketic whose telephone number is (703) 308-0134. The examiner can normally be reached on Monday through Friday (9:00-5:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703)308-5183. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

bj



9/10/03